

**IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

**INVENTOR(S):** Chris Mesa et al.

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**SERIAL NO.:** 09/944,659

**GROUP ART UNIT:** 2179

**FILED:** August 31, 2001

**EXAMINER:** T. Chuong

**TITLE:** Scanning To At Least One Of Multiple Destinations

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**AMENDED APPEAL BRIEF (FOR THE THIRD APPEAL)**

This amended appeal brief is submitted in response to the Notification of Non-Compliant Appeal Brief mailed July 27, 2007. Section 5, Summary Of Claimed Subject Matter, has been amended. No other changes were made to the Appeal Brief as originally filed (except for these introductory paragraphs). Applicants have provided both a concise explanation of the determinative subject matter of the independent claims along with a listing of the claim elements in an effort to concisely explain the subject matter and to provide supporting citations to every claim element.

While the Applicants have made a good faith effort to meet the concerns noted by the Supervisory Patent Examiner in the Notification, the Supervisory Patent Examiner's remarks are not consistent with Rule 41.37(c)(1)(v), which requires a "concise explanation of the subject matter defined in each of the independent claims ...." The rule does not require a concise explanation of the subject matter defined in "each limitation" in each independent claim, as asserted by the Supervisory Patent Examiner. Nor does the rule require the Applicants to identify in the Summary "each independent claim involved in the appeal and each independent claim argued separately", as asserted by the Supervisory Patent Examiner. No such requirement appears in the rule.

Finally, Applicants note with some frustration that the July 27, 2007 Notification of Non-Compliant Appeal Brief is substantially the same as the August 23, 2006 Notification of Non-Compliant Appeal Brief issued in the prior (second) appeal despite the fact that the objectionable text is identical to the text accepted by the Supervisory

Patent Examiner a year ago (the Summary section of this most recent Appeal Brief is identical to the Summary section of the amended appeal brief filed a year ago in the second appeal in response to the August 2006 Notification of Non-Compliant Appeal Brief -- apparently to the satisfaction of the Supervisory Patent Examiner because no objection was made to the amended appeal brief for the second appeal).

The following paragraph was included as the introductory paragraph for the original appeal brief for this third appeal.

This Appeal Brief (For The Third Appeal) accompanies a Notice of Appeal filed in response to the Office Action mailed February 15, 2007. In response to the appeal brief filed in the prior (second) appeal, the Examiner advances new grounds for rejection. The Applicants have elected to initiate a new appeal to address the new grounds, rather than reply to the latest Office Action under Rule 1.111.

**1. REAL PARTY IN INTEREST.**

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

**2. RELATED APPEALS AND INTERFERENCES.**

There are no other appeals or interferences known to Appellants, Appellants' legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**3. STATUS OF CLAIMS.**

Claims 23-31 are pending. Claims 1-22 have been canceled. The rejection of Claims 25-27 and 30-31 is appealed. The rejection of Claims 23-24 and 28-29 is not appealed.

#### **4. STATUS OF AMENDMENTS.**

All amendments have been entered. No amendments were filed after the most recent final action.

#### **5. SUMMARY OF CLAIMED SUBJECT MATTER.**

The following "concise explanation" of the subject matter recited in each of the independent claims is provided solely because it is required as a "summary" by 37 C.F.R. § 41.37(c)(1)(v). This explanation/summary is not intended to nor does it define the claimed subject matter and, therefore, it should not be used to interpret the claims or to limit or narrow the scope of the claims.

Independent Claims 23, 27, 28 and 31 are involved in the appeal.

##### Independent Claim 23.

Concise explanation of the subject matter defined in Claim 23: a method through which an input peripheral scans a document in response to the destination device requesting that the input peripheral begin transmitting data.

Support for the subject matter of Claim 23 is found in the drawings and Specification as follows: displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability (Fig. 1, display 114; Fig. 2, step 210; and Specification, page 9, lines 21-23 and page 11, lines 8-10); the input peripheral notifying a selected destination device that the device has been selected to receive data (Fig. 2, step 214 and Specification, page 11, lines 12-13); in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device (Fig. 3, step 316 and Specification, page 12, lines 2-3); and in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device (Fig. 2, steps 216, 218 and 220 and Specification, page 11, lines 17-20).

##### Independent Claim 27.

Concise explanation of the subject matter defined in Claim 27: a method through which an input peripheral scans a document in response to the destination device acknowledging a notification from the input peripheral; and a two-tiered destination selection scheme -- displaying a user interface from which multiple destination devices

and a resource on the destination device(s) may be selected to receive data from the input peripheral.

Support for the subject matter of Claim 27 is found in the drawings and Specification as follows: displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral (Fig. 2, step 210 and Specification, page 10, lines 8-21 and page 11, lines 8-10); the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data (Fig. 2, step 214 and Specification, page 11, lines 12-13); in response to the notifying, the selected destination device acknowledging a notification from the input peripheral (Fig. 3, step 316 and Specification, page 12, lines 2-3); and in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral (Fig. 2, steps 216, 218 and 220; Fig. 3, steps 318 and 320; and Specification, page 11, lines 17-20 and page 12, lines 4-5).

Independent Claim 28.

Concise explanation of the subject matter defined in Claim 28: a computer readable medium having computer executable instructions thereon through which an input peripheral scans a document in response to the destination device requesting that the input peripheral begin transmitting data.

Claim 28 is a computer medium counterpart to method Claim 23 and, therefore, the supporting citations to the Specification and drawings are the same as for Claim 23, set forth above.

Independent Claim 31. Concise explanation of the subject matter defined in Claim 31: a computer readable medium having computer executable instructions thereon through which an input peripheral scans a document in response to the destination device acknowledging a notification from the input peripheral; and a two-tiered destination selection scheme – displaying a user interface from which multiple destination devices and a resource on the destination device(s) may be selected to receive data from the input peripheral.

Claim 31 is a computer medium counterpart to method Claim 27 and, therefore, the supporting citations to the Specification and drawings are the same as for Claim 27, set forth above.

**6. GROUNDS FOR REJECTION TO BE REVIEWED.**

A. Claims 25-27 and 30-31 stand rejected under Section 102(b) as being anticipated by Monty (5799070).

B. The Specification was objected to under Rule 1.75(d)(1) as failing to provide antecedent basis for the claimed subject matter.

**7. ARGUMENT.**

**A. Claims 25-27 and 30-31 stand rejected under Section 102(b) as being anticipated by Monty.**

Claims 25-27 and 30-31 have been rejected under Section 102(a) as being anticipated by Monty (5799070).

Claims 25 and 27 recite a two tiered destination selection scheme -- (1) displaying a user interface from which one or more of multiple destination devices and a resource on one or more of the devices may be selected to receive data from an input peripheral and (2) the input peripheral transmitting data representing the document to the resource on the selected destination device(s). Claims 30 and 31, as computer medium counterparts to method Claims 25 and 27, contain similar limitations.

The Examiner asserts the fax number of the destination device in Monty is the claimed resource. This assertion is not correct. Monty teaches only the selection of a destination device represented by its fax number, not a resource on the destination device.

The Examiner's analysis of Claim 25 on page 5 of the Office Action is set forth below in full.

As to claim 25, Monty shows the method further comprising displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral and wherein the input peripheral scanning a document and transmitting data representing the document to the selected destination device comprises the input peripheral scanning the document

and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral (Monty shows that the user can dial the fax number (a resource) from the front panel/user interface 10, e.g., col. 3 lines 28-42, and fig. 1).

The cited passage in Monty teaches a conventional faxing sequence in which the user enters (or selects) the number of the destination device on the sending device, the sending device dials the number, the two devices shake hands, and then the sending device scans and transmits the document to the destination device. There is nothing in Monty that suggests the fax number of the destination device is a resource on the destination device, as opposed to the destination device itself.

The following example from page 10 of the Specification may help illustrate the distinction.

"The display may, for example, show more specific listings such as:

Anne's PC:Email

Anne's PC:AppName

Bill's PC:Fax

Bill's PC:FileName

Fred's NT Machine:AppName

In these examples, the text prior the [sic] colon (":") indicates the primary target (i.e., the host). The text following the colon indicates the secondary target (e.g., the name of the application to receive the data, the name of the file to store the data, etc.). Alternatively, the options may be displayed in the step-through type hierarchy. In such a scenario, after the user selects a primary target, a list of 20 secondary targets associated with that primary target is displayed. The user may select the secondary target from that list."

In this example, the user interface display allows the user to select the destination device (e.g., Anne's PC) and a resource on the destination device (the email or an application on Anne's PC). Monty does not teach any such two-tiered destination selection scheme. The Examiner has, therefore, failed to establish a prima facie case of anticipation.

The rejection of Claims 25-27 and 30-31 should be reversed.

**B. The Specification was objected to under Rule 1.75(d)(1) as failing to provide antecedent basis for the claimed subject matter.**

The Examiner's remarks supporting the objection to the Specification under Rule 1.75(d)(1) are quoted below in full.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(I) and MPEP § 608.01(0). Correction of the following is required: a computer readable medium as claimed in claims 28 and 31 is not specifically defined what exactly the computer readable medium is from a list of hardware and devices listed in the specification (pages 18-19). The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrase used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

A computer readable medium claim has been present in this application since it was filed, yet the Examiner has waited until the fifth action on the merits to raise this objection. The lengthy delay itself casts doubt on the propriety of the objection. In any event and as detailed below, the objection is without merit and should be withdrawn.

Rule 1.75(d) requires that "the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." So far as Applicants are aware, however, Rule 1.75(d) does require that a computer readable medium be "specifically defined ... from a list of hardware and devices...." Certainly, the Examiner has not cited any authority in support of this requirement. The objection should be withdrawn for this reason alone.

There is nothing inherently ambiguous or vague about the term "computer readable medium." Indeed, it is a well known term used frequently in patents to denote any of numerous types of computer programming media. The Specification discloses specific examples of computer readable media that may be used to implement exemplary embodiments. Fig. 4 and the accompanying description beginning on page 18, line 15, in the Specification shows "an exemplary computing device 400 that may be utilized to implement a portion of the exemplary kick-pull scan destination director." Computing device 400 includes "memory 408 (such as ROM and/or RAM), a disk drive 410, a floppy disk drive 412, and a CD-ROM drive 414." ROM, RAM, hard disks, floppy

disks and CD-ROMs are all well known forms of computer readable media. The Specification also states, for example, that Figs. 2 and 3 show "methodological implementations" that "may be performed in software, hardware, or a combination thereof." Specification page 11, line 6. Thus, the computing device in MFP 110 displaying a user interface listing the primary and secondary targets in step 210 of Fig. 2, for example, may use computer readable instructions on one or more of a memory 408, disk drive 410, floppy disk drive 412 or CD-ROM drive 414 from exemplary computing device 400 in Fig. 4 to perform this step.

Applicants respectfully submit that an ordinarily skilled artisan could readily ascertain the meaning of a "computer readable medium" by reference to the description.

Respectfully submitted,

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## APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

23.(not appealed) A scanning method, comprising:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability;

the input peripheral notifying a selected destination device that the device has been selected to receive data;

in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device; and

in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device.

24.(not appealed) The method of Claim 23, wherein the input peripheral comprises a scanner or a multifunction peripheral.

25. The method of Claim 23, further comprising displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral and wherein the input peripheral scanning a document and transmitting data representing the document to the selected destination device comprises the input peripheral scanning the document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

26. The method of Claim 25, wherein the resource comprises an application program, a telephone number for a facsimile transmission of the data, an email address to send the data, or a storage location to store the data.

27. A scanning method, comprising:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral;

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data;

in response to the notifying, the selected destination device acknowledging a notification from the input peripheral; and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

28.(not appealed) A computer readable medium having computer executable instructions thereon for:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability;

the input peripheral notifying a selected destination device that the device has been selected to receive data;

in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device;

in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device.

29.(not appealed) The medium of Claim 28, wherein the input peripheral comprises a scanner or a multifunction peripheral.

30. The medium of Claim 28, further comprising instructions for displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral and wherein the instructions for the input peripheral scanning a document and transmitting data representing the document to the selected destination device comprise instructions for the input peripheral scanning the document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

31. A computer readable medium having computer executable instructions thereon for:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral;

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data;

in response to the notifying, the selected destination device acknowledging a notification from the input peripheral; and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

**APPENDIX II -- EVIDENCE SUBMITTED UNDER RULES 130, 131 OR 132**

none

### APPENDIX III -- RELATED PROCEEDINGS

none